REMARKS

Applicants appreciate the Office Action of December 15, 2004. As a preliminary note, Applicants are responding to the previous office action as if the Amendment of November 25, 2003 accompanying Applicants' Request for Continued Examination was not entered as stated in the Office Action at page 3. Applicants have amended the claims as set out above. In particular, Applicants have canceled Claims 3, 4, 13, 14, 23, 24, 31, 33 and 35 from the present application. Claims 6, 16 and 26 have been amended to include a new recitation and written in independent form. Claims 7, 9, 10, 17, 19, 20, 27, 29 and 30 have been amended to further clarify aspects of the present invention. Finally, Applicants have added new Claims 37 through 45. Applicants respectfully submit that the pending claims are patentable over the cited references for at least the reasons discussed below. Furthermore, Applicants have clarified the recitations objected to in the Office Action into dependent Claims 37, 40 and 43. Applicants submit that there is support in the specification for dependent Claims 37, 40 and 43 and that no new matter has been added to the present application. Furthermore, Applicants submit that the drawings are in compliance with 37 C.F.R. § 1.83(a) for at least the reasons discussed below. Accordingly, the pending claims are in condition for allowance, which is respectfully requested in due course.

Applicants Have Not Admitted Any Prior Art

The Office Action states:

> Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous office action(s) pursuant to the requirements set forth under MPEP § 2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office Action, i.e. PROFILEATTRS attribute, are now established as admitted prior art of record for the course of the prosecution.

See Office Action, page 5, paragraph 19. Applicants respectfully submit that the Examiner has changed his assertion with respect to the PROFILEATTRS attribute. The previous Office Action states that "Official Notice is taken that it was common practice to have an attribute **similar** to PROFILEATTRS at the time the instant invention was made." *See* Office Action,

page 5, line 22. Nothing in any of the previous Office Actions states that the PROFILEATTRS attribute as described in the present application is "well known" as stated in the present Office Action.

To the extent that the Office Action is asserting that the operation/use of an attribute as described in the present application with reference to the PROFILEATTRS attribute is known, Applicants dispute such an assertion. Furthermore, Applicants respectfully submit that "similar" is not statutory language. Applicants concede that "tags" used to link other documents are known. Furthermore, Applicants also concede that it is known to include one or more attributes within a tag. However, the Office Action does not define "similar" attributes or provide any support for the assertion that attributes "similar" to PROFILEATTRS as described in the present application are common practice in the art. Applicants have consistently maintained that an attribute such as the PROFILEATTRS attribute described in the present application is not known. Applicants respectfully submit that nothing in the cited references discloses or suggests the "PROFILEATTRS" attribute as described in the specification of the present invention. However, in the interest of expediting prosecution of the present application, Applicants have canceled Claims 3, 13 and 23 from the present application.

Amended Independent Claims 1, 11 and 21 are Patentable Over Merriman

Claims 1, 2, 11, 12, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 5,948,061 to Merriman *et al.* (hereinafter "Merriman"). Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by the cited reference. For example, Amended Claim 1 recites:

> **In a networked environment, a method for designating client properties comprising:**
> **receiving a link element associated with a server, the link element including a plurality of requested client properties;**
> selecting said link element to request a document identified by the link element to be transmitted to a client;
> **inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by**

the link element based on the inserted at least one of said plurality of requested client properties.

Claims 11 and 21 contain corresponding system and computer program product claims.

Applicants submit that at least the highlighted portions of, for example, Amended Claim 1, are neither disclosed nor suggested by Merriman.

The Office Action states that Merriman teaches all the recitations of, for example, Claim 1. *See* Office Action, page 4, paragraphs 6-15. The cited portion of Merriman recites, in part:

> In FIG. 1, a user operates a web browser, such as Netscape or Microsoft Internet Explorer, on a computer or PDA or other Internet capable device 16 to generate through the hypertext transfer protocol (HTTP) 14 a request 20 to any one of preferably a plurality of affiliate web sites 12. The affiliate web site sends one or more messages back 22 using the same protocol. **Those messages 22 preferably contain all of the information available at the particular web site 12 for the requested page to be displayed by the user's browser 16 except for one or more advertising objects such as banner advertisements.** These objects **preferably do not reside** on the affiliate's web server. Instead, the affiliate's web **server sends back a link including an IP address for a node running an advertiser server process 19 as well as information about the page on which the advertisement will be displayed.** The link by way of example may be a hypertext markup language (HTML) <img> tag, referring to, for example, an inline image such as a banner. The user's browser 16 then **transmits a message 23** using the received IP address to access such an object indicated by the HTML tag from the advertisement server 19. **Included in each message 23 typically to the advertising server 19 are:** (i) the user's IP address, (ii) a cookie if the browser 16 is cookie enabled and stores cookie information, (iii) a substring key indicating the page in which the advertisement to be provided from the server is to be embedded, and (iv) MIME header information indicating the browser type and version, the operating system of the computer on which the browser is operating and the proxy server type. Upon receiving the request in the message 23, the advertising server process 19 determines which advertisement or other object to provide to user's browser and transmits the messages 24 containing the object such as a banner advertisement to the user's browser 16 using the HTTP protocol. **Preferably contained within the HTTP message is a unique identifier for the advertiser's web page appropriate for the advertisement.** That advertisement object is then displayed on the image created by the web user's browser as a composite of the received affiliate's web page plus the object transmitted back by the advertising web server.

See Merriman, column 3, lines 24-63. In other words, a user selects a hyperlink presented on

a browser, for example, Netscape, and the browser retrieves all of the information available at the web site, for example, a requested document, except for certain advertising objects. Once all the available information is obtained, the browser transmits a message 23 to an advertising server that uses the information provided in the message 23 to attach an advertisement to the requested information (requested document) that may be tailored for the specific user or computer. Thus, the advertisement, not the requested information, is tailored to the user/computer based on the information provided in the message 23.

As further recited in Merriman:

> As part of the "click through" process, when the user clicks on the banner or other advertising object displayed by the user's browser 16, the user's browser again transmits a message to the ad server. The ad server notes the address of the computer of the browser (or any other identifier such as a cookie or a digital signature) that generated the message 23 and transmits back the URL of the advertiser's web page so that the user's web browser 16 generates a message 26 to contact the advertiser's web site. 18. The ad server process 19 also notes that a "click through" for an advertisement has occurred and updates the various databases in the manner described below.

See Merriman, column 3, line 64 through column 4, line 11. In other words, a database management company, for example, Double Click, maintains databases including user/computer specific information. Each user/computer is assigned an identifier. The user's activities are then monitored by, for example, tracking the users click stream data, i.e. what web sites a user visits, what information is accessed from those websites and the like. This information is stored in a database referenced by the identifier and may also be used to tailor the advertisements presented on the user's display. Accordingly, Merriman discusses a method of tailoring advertisements placed on or around requested documents/information on a display based on information provided by the user and/or a user's web activities.

In contrast, Amended Claim 1, for example, recites receiving a link element associated with a server, the link element including a plurality of requested client properties and inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties. Nothing in Merriman discloses or suggests at least these recitations of Claims 1, 11 and 21. The cited portion of

Merriman set out above discusses a server that sends a link back to the browser including an IP address for a node running an advertiser server process as well as information about the page on which the advertisement will be displayed and a user's browser that transmits a message to the advertising server. The link discussed in Merriman does not appear to specify requested client properties, but appears to specify a server property and web page information. Nothing in the cited portion of Merriman discloses or suggests receiving a link element from the server including a plurality of **requested client properties**, inserting at least one of these **requested client properties** into a request and using the at least one **requested client properties** to customize the requested document. In fact, it appears as if the message 23 of Merriman includes information stored in a user profile or cookie and that the information in this user profile or cookie is dumped into the message 23. In contrast, the claims of the present invention recite receiving a link element including a plurality of **requested client properties** at least one of which is inserted into a request so as to allow customization of the requested document. Thus, according to embodiments of the present invention the server receives some or all of the information it requests, not a dump of all the information stored at the browser. Furthermore, as discussed above, Merriman discusses customizing advertisements to the user and/or computer. In contrast the present invention discusses customizing, for example, the format of the requested document to be compatible with, for example, the client device.

Accordingly, Applicants respectfully submit that Amended Independent Claims 1, 11 and 21 are not anticipated by the cited reference for at least the reasons discussed above. Thus, Independent Claims 1, 11 and 21 are patentable over the cited reference. Furthermore, dependent Claims 2, 12 and 22 are patentable at least per the patentability of Independent base Claims 1, 11 and 21 from which they depend. Accordingly, Applicants submit that Independent Claims 1, 11 and 21 and the claims that depend therefrom are in condition for allowance, which is respectfully requested in due course.

The Dependent Claims are Patentable at least per the Patentability of the Base Claims

Claims 3, 13 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Merriman. Claims 4, 5, 14, 15, 24, 25, 32, 34 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of United States Patent No. 6,401,085 to Gershman (hereinafter "Gershman"). Claims 6, 7, 10, 16, 17, 20, 26, 27 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of United States Patent No. 6,098,081 to Heidorn et al. (Hereinafter "Heidorn"). Finally, Claims 8, 9, 18, 19, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman. Applicants have canceled Claims 3, 4, 13, 14, 23 and 24 from the present application and, therefore submit that the rejections with respect to these claims have been obviated. Applicants respectfully submit that dependent Claims 5, 7-10, 15, 17-20, 25, 27-30, 32, 34, 36-38, 40-41 and 43-44 are patentable at least per the patentability of Independent base Claims 1, 11 and 21 from which they depend.

Many of the Dependent Claims are Independently Patentable

As discussed above, the dependent claims are patentable over the cited references at least per the patentability of the independent base claims from which they depend. Many of the dependent Claims are also independently patentable.

For example, Claim 7 recites, in part:

> wherein said step of inserting comprises the steps of:
> selecting ones of the plurality of requested client properties included in the link element; and
> determining whether selected ones of the plurality of requested client properties are available to be transmitted.

Claims 17 and 27 contain corresponding system and program product recitations. As discussed above with respect to Claims 1, 11 and 21, nothing in the cited references discloses or suggests a link element including a plurality of requested client properties or inserting at least one of the requested client properties into a request. Thus, it follows that nothing in the cited references discloses or suggests details with respect to inserting the at least one of the requested client properties into the request. Accordingly, Claims 7, 17 and 27 are independently patentable over the cited references for at least these additional reasons.

By way of further example, Amended Claim 9 recites:

The method of Claim 7 further comprising:

prompting a user whether to transmit the selected ones of the plurality of requested client properties if it is determined that at least one of the plurality of requested client properties is available to be transmitted; and

transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent.

Claims 19 and 29 contain corresponding system and computer program product recitations. As stated above, Claims 9, 19 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman in view of Heidorn in further view of Gershman. The Office Action admits that Merriman does not specifically teach that the step of prompting a user whether to transmit said each one property as recited in Claim 9. *See* Office Action, page 10, paragraph 42. The Office Action further admits that Heidorn does not fully provide the missing teachings. *See id.* However, the Office Action points to the combination of Heidorn and Gershman to provide the missing teachings. *See id.* Applicants respectfully disagree.

Heidorn discusses "soft hyperlinks", *i.e.* a link that is not fully resolved when it is written. *See* Heidorn, column 3, lines 22-23. The cited portion of Heidorn discusses resolving soft hyperlinks by executing rules contained therein, but does not discuss prompting a user for permission to transmit information as recited in Claims 9, 19 and 29. *See* Heidorn, column 3, line 54 to column 4, line 34. Gershman discusses a system for displaying and retrieving information from the web using a handheld device. *See* Gershman, column 3, lines 14-29. The cited portion of Gershman discusses prompting the user to input information of interest to the user, but does not prompt the user for permission to transmit information requested in a link as recited in Claims 9, 19 and 29. *See id.* Thus, the cited portions of Heidorn and Gershman do not disclose or suggest "prompting a user whether to transmit the selected ones of the plurality of requested client properties" as recited in Amended Claims 9, 19 and 29. Furthermore, nothing in the cited references discloses or suggests "transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent" as further recited in Claims 9, 19 and 29. Accordingly, Claims 9, 19 and 29 are independently patentable over the cited references for at least these additional reasons.

By way of Final example, Claim 10 recites "terminating the request if it is determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted and the at least one of the selected ones of the plurality of requested client properties that is not available to be transmitted is a mandatory property." Claims 20 and 30 contain corresponding system and program product recitations. Nothing in the cited references discloses or suggests that at least one of the plurality of client properties is designated as a mandatory property, thus, it also follows that none of the cited references discloses or suggests terminating the request based on the mandatory property not being available to be transmitted as recited in Claims 10, 20 and 30. Accordingly, Claims 10, 20 and 30 are independently patentable over the cited references for at least these additional reasons.

Accordingly, none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, there is no motivation or suggestion to combine the cited references as suggested in the Office Action. As recently affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

For example, with respect to Claims 9, 19 and 29 the Office Action states:

> It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman and Heidorn with Merriman because make a system [sic] have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (i.e. cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for its security reasons.

See Office Action, page 10. This motivation is representative of the motivations provided

throughout the Office Action. This motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action. Accordingly, the statement in Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

For at least the foregoing reasons, Applicants respectfully submit that at least the dependent claims discussed above are independently patentable over the cited references. Accordingly, Applicants submit that the dependent claims are in condition for allowance, which is respectfully requested in due course.

New Independent Claims 6, 16 and 26 are patentable

The recitations of Claims 1, 11 and 21 have been incorporated in Claims 6, 16 and 26, respectively. Thus, Claims 6, 16 and 26 are patentable for at least the reasons discussed above with respect to Claims 1, 11 and 21. Furthermore, as discussed above nothing in the cited references discloses or suggests receiving a link element including a plurality of requested client properties, thus, it follows that nothing in the cited references discloses or suggests that at least one of the plurality of requested client properties is designated as a mandatory property and at least one of the plurality of requested client properties is an optional property as recited in Claims 6, 16 and 26. Accordingly, Claims 6, 16 and 26 are independently patentable over the cited references for at least these reasons.

New Dependent Claims 39, 42 and 45 depend from Claims 6, 16 and 26 respectively. Thus, these claims are patentable at least per the patentability of the independent base claims from which they depend. Claims 39, 42 and 45 are also independently patentable as nothing in the cited references discloses or suggests "transmitting the request without at least one of the at least one property that is an optional property" as recited in Claims 39, 42 and 45.

The New Dependent Claims are Separately Patentable

Applicants have added new Claims 37-38, 40-41 and 43-44 to the present application. Applicants submit that these Claims are patentable over the cited references because nothing in the cited references discloses or suggests the plurality of requested client properties included in the link element being less than all available client properties as recited in Claims 37, 40 and 43 or the inserted at least one of said plurality of client properties being less than all the plurality of requested properties included in the link element as recited in Claims 38, 41 and 44.

The 112 Rejections

Claims 1, 11 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action states:

> Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties being less than all available client properties found in the original discloser [sic] of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

See Office Action, pages 2 and 3, paragraph 4. Applicants have removed the recitation objected to in the Office Action from Claims 1, 11 and 21, but have added this recitation in new Claims 37, 40 and 43. Applicants respectfully submit that no new matter is being added to the present application by these recitations.

As stated in the summary of the present invention:

An object of the present invention is to provide, within a networked environment, a method by which a Web server **can indicate which** device, user, software, and network **properties can it use when generating personalized content for the requesting user.**

Another object of the present invention is to provide a method by which a Web server **can indicate which** device, user, software, and network **properties are required for it to generate any meaningful content for the requesting user...**

See Summary of the Invention, page 4, line 10 to page 5, line 11. In other words, embodiments of the present invention provide methods, systems and computer program

products that allow a Web server to indicate "which properties" are used and/or required by the Web server to generate a customized output for the user. There would be no need for a Web Server to indicate which properties it can use to generate personalized content, if all of the available properties were used. It is apparent from the Summary of the Invention that the web server determines which properties it needs because less than all the properties are requested from the client.

Furthermore, methods of indicating properties that may be used by the server are discussed throughout the specification. For example, with respect to Figure 4B, the specification states:

> The server may need to indicate to the client browser that the server that provides a particular linked document is capable of customizing the content or format of that document according to the client as long as the document request includes information about the hardware device, platform or application software, or user preferences. To do this, the server may include an additional attribute (PROFILEATTRS) with the link element **listing the properties that the referenced server can use to customize the referenced document.**

See specification, page 12, lines 15-20. Again, there would be no need for a Web Server to indicate which properties it can use to customize the referenced document, if all of the available properties were indicated. Accordingly, Applicants respectfully submit that the subject matter of dependent Claims 37, 40 and 43 is not new matter for at least the reasons discussed above.

The Drawings are in compliance with 37 C.F.R. 1.83(a)

The drawings stand rejected under 37 C.F.R. 1.83(a) as failing to show every feature of the invention specified in the claims. In particular, the Office Action states that "the plurality of requested client properties being less than all available client properties must be shown or the features canceled from the claims." *See* Office Action, page 3, paragraph 5. Applicants respectfully submit that this feature is clearly illustrated in the Figures.

For example, Figure 5A illustrates the PROFILEATTRS, which designates a list of client properties that may be provided to the server from which the document is requested. As illustrated therein and described in the corresponding text, the PROFILEATTRS of Figure

5A only includes one client property, HardwareCharacteristics 346. As stated in the specification, "[t]he list 345 includes only one property...Additional properties may be included in the list 345 by separating them with a semi-colon." *See* Specification, page 13, lines 9-12. Thus, implying that there is more than one available client property. Thus, Figure 5A clearly illustrates the requested client properties being less than all available client properties as recited in dependent Claims 37, 40 and 43. *See* Figure 5A and the specification, page 13, lines 6-12.

Accordingly, Applicants respectfully submit that the drawings are in compliance with 37 C.F.R. 1.83(a) for at least the reasons discussed above. Applicants respectfully request reconsideration and withdrawal of the objections with respect to the drawings.

CONCLUSION

Applicants respectfully submit that pending claims are in condition for allowance, which is respectfully requested in due course. Favorable examination and allowance of the present application is respectfully requested. It is not believed that any extension of time is required for this paper. However, in the event that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to our Deposit Account No. 09-0461.

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 15, 2004.

Ban Younan - Signed on March 26, 2004, date of mailing

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